UNITED STATES PATENT AND TRADEMARK OFFICE

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10/624,857	07/22/2003	Glen J. Anderson	P1917US00	6519

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ART UNIT	PAPER NUMBER
2134	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-29 are presented.

Response to Arguments

Applicant's arguments filed have been fully considered. The arguments regarding the prior art are not persuasive.

Applicant's argument is that the prior art does not teach "associated" with the diagnostic code. Is this credible considering the ordinary skill in the art? This feature "associated" was cited as being taught upon studying columns 14-15 of Burnstein. Applicant discusses this section of Burnstein at pages 9-10 of Amendment. Applicant's arguments, in toto, consist of two elements: (1) the bare quote of the cited (by the previous Office Action) passages of Burnstein and (2) the conclusory paragraph stating that Burnstein does not teach the features. Thus, Applicant needs to the following: (1) Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions; (2) Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

The teachings of Burnstein were cited in conjunction with DRM. The previous Office Action noted that diagnostic tools used after authentication permits the use of diagnostic tools. Hence the "associated" was discussed. Applicant is respectfully requested to respond to this portion of the rejection.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding claims 1-29, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (computer, hardware, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an <u>algorithm</u> in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance.

USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all

claim limitations when determining patentability of an invention over the prior art. In re

Gulack, 703 F.2d 1381, 1385, 217USPQ 401, 403-04 (Fed. Cir. 1983). USPTO

personnel may not disregard claim limitations comprised of printed matter. See

Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209

USPQ at 10. However, USPTO personnel need not give patentable weight to printed

matter absent a new and unobvious functional relationship between the printed matter

and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035

(Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

For further guidance on the term "nonfunctional", please see MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Burnstein (Burnstein et al., US Patent 7,076,541) and DRM (www.reed-

electronics.comlsemiconductorlarticlelCA231640).

Regarding claim 1, DRM teaches "A computerized method for authenticating a

diagnostic code, the method comprising:

receiving a diagnostic code for a component of a computer system (DRM section

"Defining E-Diagnostics and DRM", i.e., e-diagnostics ....via network).

DRM does not teach "generating an authentication code associated with the

diagnostic code."

Burnstein teaches "generating an authentication code (column 10, line 24 to

column11, line 26, i.e., authentication such as by using start screen and domain

manager) associated with the diagnostic code (column 14, line 61 to column 15, line 67;

figure 4; claims 15,16 of Burnstein i.e. diagnostic tools used after authentication permits

the use of diagnostic tools)" for the motivation of permitting an agent to register and

manage a plurality of domain names for a plurality of different registrants (column 3,

lines 5-60) thereby including the use of diagnostics (for management) upon proper

authentication (such as would be necessary for an agent).

Hence, it would have been obvious to those of ordinary skill in the art at the time

of the claimed invention to combine the teachings of Burnstein and DRM for the

motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claim 2 (authentication code using date value, etc.), such particular

features are well known in the art for the purpose of security and for the purpose of

keeping track of data.

Regarding claim 3 (authentication code using serial number, etc.), such particular

features are well known in the art for the purpose of security and for the purpose of

keeping track of data. Regarding claims 4-8, such particular features are well known in

the art for the purpose of security.

Regarding claim 9, Burnstein teaches "A computerized system for authenticating

a diagnostic code, the system comprising:

a diagnostic module operable to perform a diagnostic on a component of a

computer system and to produce a diagnostic code(section "Defining E-Diagnostics and

Burnstein", i.e., e-diagnostics, ... via network); and

an authentication code generation module operable to generate an

authentication ... associated with the diagnostic code (section "Burnstein enterprise

server", subsection "authentication", i.e., the user privilege is associated with the

authentication for authorization, thereby the e-diagnostic is associated with the

authorization)."

These passages of Burnstein do not explicitly mention "code" in the sense of the

claim.

Nevertheless, it was well known in the art to have a "code" for the motivation of

having a physical software program for actuating the authentication algorithm (the

algorithm used in the code).

Hence, it would have been obvious to those of ordinary skill in the art at the time

of the claimed invention to modify Burnstein for the motivation noted in the previous

paragraphs so as to teach the claimed invention.

Regarding claim 9-11 (authentication code using serial number, etc.), such

particular features are well known in the art for the purpose of security and for the

purpose of keeping track of data.

Regarding claim 13 (authentication code using date value, etc.), such particular features are well known in the art for the purpose of security and for the purpose of keeping track of data. Regarding claims 14, (use of server, etc.) such particular features are well known in the art for the purpose of security across computers.

Regarding claim 15, Burnstein teaches "A computerized method for authenticating a diagnostic code, the method comprising:

receiving a diagnostic code for a component of a computer system (DRM section "Defining E-Diagnostics and DRM", i.e., e-diagnostics ....via network).

DRM does not teach "generating an authentication code associated with the diagnostic code."

Burnstein teaches "generating an authentication code (column 10, line 24 to column11, line 26, i.e., authentication such as by using start screen and domain manager) associated with the diagnostic code (column 14, line 61 to column 15, line 67; figure 4; claims 15,16 of Burnstein i.e. diagnostic tools used after authentication permits the use of diagnostic tools)" for the motivation of permitting an agent to register and manage a plurality of domain names for a plurality of different registrants (column 3, lines 5-60) thereby including the use of diagnostics (for management) upon proper authentication (such as would be necessary for an agent).

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to combine the teachings of Burnstein and DRM for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claim 16 (authentication code using date value, etc.), such particular features are well known in the art for the purpose of security and for the purpose of keeping track of data.

Regarding claim 17 (authentication code using serial number, etc.), such particular features are well known in the art for the purpose of security and for the purpose of keeping track of data. Regarding claims 18-29, such particular features are well known in the art for the purpose of security.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or

"DRAFT")

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Jung whose telephone number is (571) 272-3836

or Kambiz Zand whose telephone number is (272) 272-3811.

David Jung

Patent Examiner

11/12/07